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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/430,177	10/29/1999	UPVAN NARANG	100448.01	6878

27049 7590 03/13/2002

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EXAMINER
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WARE, TODD

ART UNIT	PAPER NUMBER
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1615

DATE MAILED: 03/13/2002

17

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/430,177

Applicant(s)

NARANG ET AL.

Examiner

Todd D Ware

Art Unit

1615

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 17 December 2001.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-144 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) 1-40, 43-45, 47-83, 86-88, 90-137, 140-144 is/are rejected.
- 7) ☒ Claim(s) 41,42,46,84,85,89,138 and 139 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

### Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

### Attachment(s)

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_.
- ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_.
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: \_\_\_\_\_.

**DETAILED ACTION**

Receipt of response filed 12-17-01 is acknowledged.

***Claim Rejections - 35 USC § 103***

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1-40, 43-45, 47-83, 86-88, 90-137, 140-144 are rejected under 35 U.S.C. 103(a) as being unpatentable over Clark et al (WO 97/31598; hereafter '598) or Leung (WO 96/40797; hereafter '797).

'598 and '797 teach substantially the same methods of making applicator tips and applicators as the instant claims. The applicators and applicator tips of '598 and '797 comprise antibacterial agents and the applicators have a conduit for an adhesive composition where the composition may flow through the applicator to the applicator tip. The tips are porous and may be made of foam in a variety of shapes. Neither '598 nor '797 teaches the specific antimicrobial agents of the instant claims, however it is submitted that these agents are known antimicrobial agents and based upon the inclusion of antimicrobial agents in '598 and '797 it would have been obvious to one skilled in the art at the time of the invention to include the specific antimicrobial agents, absent a demonstration of criticality thereto.

'598 and '797 also do not teach forming a concentration gradient of the agent, however it would have been obvious to one skilled in the art at the time of the invention to utilize a concentration gradient to allow the initiator to flow in the applicator tip. As the applicator is used, the initiator polymerizes the polymer and its concentration decreases. Substances flow from high concentration to low concentration according to diffusion, which is the net movement of molecules in the direction of lower concentration.

'598 and '797 also do not teach kits comprising saleable packages comprising the applicators and applicator tips, however they do teach separate storage within an applicator container. Purchase or ability to sell the kits would have been obvious to one skilled in the art at the time of the invention to provide a convenient means for distribution.

'598 and '797 do not teach methanol as the solvent, however they do teach ethanol as the solvent, which differs as an adjacent homolog. Therefore, the claimed invention would have been obvious to the skilled artisan because close structural similarity of the reference compound suggests the claimed compound. One skilled in the art would expect the two compounds to have similar properties.

'598 and '797 also meet the requirement where the applicator tip is made of reticulated material. Merriam Webster's Collegiate Dictionary defines reticulated as "constructed so as to form a network." '598 and '797 disclose that the applicator tip is composed of a honey-comb material or a material having a woven pattern.

'598 and '797 also meet the requirement where the applicator body is free of a polymerizable adhesive reservoir as they disclose that the applicator body is a swab. Furthermore, these references also meet the requirement where the method of making utilizes a vacuum as they disclose heating the applicator tip in a vacuum oven.

***Response to Arguments***

3. Applicant's arguments filed 12-17-01 have been fully considered but they are not persuasive. Applicants argue that the instant claims are non-obvious on the basis that the instant specification provides data demonstrating unexpected results. In response, it is noted that the specification compares methanol with acetone, while the rejection is based upon ethanol, which is the nearest homolog of methanol. Applicants arguments that acetone and ethanol would provide the same results are not persuasive. Acetone has a ketone group while ethanol has an alcohol group. Thus, depending upon components, they would be expected to behave/react differently. Furthermore, the instant claims require that the solvent comprises methanol. They do not state that the solvent consists of methanol. Accordingly, the claims are not commensurate with the scope of the specification, since the specification only shows methanol as the solvent.

4. Applicants' comments regarding instant claims 26 and 76 where methanol is not required are not understood. These claims both include methanol. Furthermore, applicants' comments pertaining to limitations where the bioactive is a non-initiator or rate modifier are not persuasive as these claims recite a Markush group that includes both a bioactive material that is also a polymerization initiator or a polymerization rate

modifier and a bioactive material that is neither a polymerization initiator or a polymerization rate modifier.

5. Arguments' arguments regarding instant claim 50 are not persuasive. It is agreed that the reference states "subsequent to application of the initiator," however it is not agreed that this is a step apart from applying at least one agent from the instant group. Indeed the reference specifically states that the medium is impregnated (applied to) in the applicator tip in this fashion, page 18, lines 10-11. Thus, this step is not separate from application of an agent.

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6. Arguments' arguments regarding instant claim 52 are not persuasive. Applicants argue that porous and reticulated are not synonymous but have not provided any evidence of non-obviousness. It is again noted that the references teach that the applicator tip is composed of a honey-comb material or a material having a woven pattern, not just porous.

#### ***Allowable Subject Matter***

7. Claims 41-42, 46, 84-85, 89, 138-139 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

#### ***Conclusion***

8. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

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A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Todd D Ware whose telephone number is (703) 305-1700. The examiner can normally be reached on 7:30 AM - 4 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Thurman K Page can be reached on (703)308-2927. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 308-4556 for regular communications and (703) 308-4556 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1234.

  
THURMAN K. PAGE  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 1600